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09/400,724

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MARK E. OGRAM

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06/09/2005

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/400,724

Applicant(s)

OGRAM, MARK E.

Examiner

Dennis Ruhl

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's response of 8/1/03 has been entered. Currently claims 1-5,7-10, are pending. The instant examiner has reviewed the prosecution history to date and notes the previous rejections of record and arguments presented by applicant.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 3, there is no antecedent basis for "said representation of said transaction indicia". This was previously part of claim 1 but was canceled from that claim in the most recent amendment so now this term has no antecedent basis in claim

3. What does this term even refer to? No transaction indicia is claimed in claim 1 so what is the representation of the transaction indicia? This is not clear.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5,7-10, are rejected under 35 U.S.C. 102(e) as being anticipated by Payne et al. (5715314).

For claims 1, Payne discloses a system as claimed. Payne discloses a merchant computer 14, financial computer 16, and a consumer computer 12. The claimed means for receiving customer account data and amount data via a computer network (the Internet) is considered to be either a modem of the financial computer or is considered to be the software/hardware that the financial computer uses to receive data over the network. The means for establishing an authorization indicia from a bank computer (considered the financial computer 16) is satisfied by the disclosed "access URL authenticator", see column 7, lines 15-31. The means for connecting the consumer computer to a selected site within the merchant computer is disclosed in column 7, lines 31-39 where it is disclosed that the financial computer sends a "redirect to access URL" to the consumer computer after authorization of the purchase is confirmed. The URL is a link that connects the consumer computer to a site in the merchant computer so that the merchant computer knows that the payment has been completed and the user is authorized to view the purchased article.

For claims 2,3, the claimed "means for communicating" the password and representation of indicia is considered to be either a modem of the financial computer or is considered to be the software/hardware that the financial computer uses to send and receive data over the network. This limitation is just claiming a means for communicating, where the claimed password and representation of indicia is just reciting the kind of data that the means for communicating can communicate.

For claims 4,5, the means for receiving data (addressed in claim 1) allows for a data link to be established with another computer as claimed. If you can receive data via a modem, then you have a way to establish a data link with another computer. Payne anticipates what is claimed.

For claim 7, Payne discloses a system as claimed. Payne discloses a merchant computer 14, financial computer 16, and a remote computer 12. The computer network is the Internet that is disclosed in column 4, lines 43-45. The merchant computer contains promotional data as claimed. The promotional data is the summaries of various articles that are available for purchase by the consumer, see column 4, lines 50-60. The "means for communicating order information" via the network is considered to be either a modem of the merchant computer or is considered to be the software/hardware that the merchant computer uses to send and receive data over the network. The merchant computer has a means for communication as claimed. The financial computer has means for receiving account data and amount data via the network and this is also considered to be either a modem of the financial computer or is considered to be the software/hardware that the financial computer uses to receive data. The means for connecting the consumer computer to a selected site within the merchant computer is disclosed in column 7, lines 31-39 where it is disclosed that the financial computer sends a "redirect to access URL" to the consumer computer after authorization of the purchase is confirmed. The URL is a link that connects the consumer computer to a site in the merchant computer so that the merchant computer knows that the payment has been completed and the user is authorized to view the

purchased article. The claimed authorization indicia is considered to be the "access URL authenticator" disclosed by Payne as being created.

For claim 8, the claimed automatic means for generating a shipping order is interpreted by the examiner to be the command that allows the user access to the purchased article (or the goods if a real product is being purchased). Once the merchant computer knows that the consumer has paid for the article, the merchant computer allows access, which is equivalent to generating a "shipping order". In the embodiment where a real good is purchased (as opposed to a text article), once the merchant knows you have paid for the good, the good must be shipped to the consumer. In this example a shipping order is necessarily present because the merchant computer will instruct the shipping of the product to the consumer once payment has been verified.

For claim 9, the claimed "means for communicating" the password is considered to be either a modem of the financial computer or is considered to be the software/hardware that the financial computer uses to send and receive data over the network. The merchant computer has a database 15 that stores secured data (articles) as claimed. The means for transmitting the secured data is considered to be either a modem of the merchant computer or is considered to be the software/hardware that the merchant computer uses to send and receive data over the network.

For claim 10, this claim is reciting a method step in an article claim, which is nothing more than a recitation of the intended use of the article (the claimed system). This defines nothing further to the structure recited in claim 7. A recitation of the

intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, which in this case it is, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

1. Applicant's arguments with respect to claims 1-5,7-10 have been considered but are moot in view of the new ground(s) of rejection.

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER